

REMARKS

Claims 1-26 are pending in the application.

Claims 1-26 have been rejected.

Claims 1-26 have been amended, as set forth above.

New Claims 27-32 have been added.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1-9, 11-18, 20-24 and 26-27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Orbach (U.S. Patent Application Publication No. 2004/0125932). This rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The Applicant respectfully submits that the Applicant's claimed invention is not anticipated by the Orbach reference. The Applicant respectfully directs attention to certain unique and novel elements of Claim 1, as amended:

1. (Currently Amended) A method for call conferencing **in an Internet Protocol (IP) communications network**, the method comprising:
 - controlling a conference call with **a server within the IP network**;
 - detecting an event associated with the conference call, the conference call associated with a plurality of participants **within the IP network**;
 - generating at the server one or more instant message associated with the detected event, **the one or more instant messages having Session Initiation Protocol (SIP) format**; and
 - communicating the one or more **SIP instant messages** from the server to one or more of the participants. (emphasis added).

To further prosecution, Applicant has amended independent Claim 1 to recite, generally, (1) the server is within an Internet Protocol (IP) communications network, (2) the conference call is controlled within the IP network, (3) the server controlling the conference call generates instant messages in response to a detected event, with the instant messages in a specific format -- Session Initiation Protocol (SIP) format, and (4) the server transmits the SIP instant messages to the participant.

As presently understood, Orbach teaches a telephony switch controlling a conventional conference call within a conventional telephony network. Orbach, Figure 1, paragraphs 0011, 0013, 0040. In contrast, the claimed invention includes a method performed by a server within an IP network having one or more conference call participants within the IP network. The instant messages communicated by the server to a participant are in a specific format – the SIP format. This format and messaging is different than conventional telephony. Orbach is directed to conventional telephony, as Orbach teaches a conference information manager 30, *shown as a device separate and apart from the telephone switch 16 (which controls the conference call)*, and event messages transmitted over an “IP-line”, as either an SMS or a WAP-push message. Orbach, paragraph 0058, 0099. Thus, Orbach’s telephone switch and conferencing functions are conventional, and are not directed to IP networks. Further, Orbach teaches two specific formats for event messages transmitted from the CIM 30 (which is a device separate from the telephone switch) – SMS or WAP, while Applicant’s claims recite SIP formatted instant messages. Though Orbach briefly discloses additional messages in SMS, MMS, WAP or TCP/IP channel, these messages are limited to only messages transmitted from a call participant. Orbach, paragraph 0061.

Therefore, Orbach fails to disclose each and every element as specifically recited and arranged in amended Claim 1.

With respect to independent Claims 11 and 20, the Office Action rejects these claims based on the same rationale as the rejections of independent Claim 1. Applicant has amended independent Claims 11 and 20 to be generally consistent with amended independent Claim 1,

and therefore, the above arguments apply equally to amended independent Claims 11 and 20.

Accordingly, Applicant respectfully requests the Examiner withdraw the § 102(e) rejections of Claims 1-9, 11-18, 20-24 and 26.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 10, 19 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Orbach (U.S. Patent Application Publication No. 2004/0125932) in view of Desai (US Patent No. 6,618,746). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second,

there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

As noted above, Orbach fails to disclose each and every element/feature in amended independent Claims 1, 11 and 20. Desai does not appear to cure the noted deficiencies.

In addition, Applicant submits that the proposed motivation for combining the Desai reference with the Orbach reference is too general and is therefore legally insufficient to serve as a motivation for combining the references.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) obviousness rejections of Claims 10, 19 and 25.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the patent application are in condition for allowance, and respectfully requests an early allowance of such claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge \$312.00 for six additional dependent claims, or any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

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